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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/396,005	09/13/1999	KHAI HEE KWAN		6815

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EXAMINER

LE, DAVID Q

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 03/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

SK

<b>Office Action Summary</b>	<b>Application No.</b> 09/396,005	<b>Applicant(s)</b> KWAN, KHAI HEE	
	<b>Examiner</b> David Q Le	<b>Art Unit</b> 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 December 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 13-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

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## **DETAILED ACTION**

### ***Examiner's note***

1. The Examiner has pointed out particular references contained in the prior art of record in the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claims, other passages and figures apply as well. It is requested from the Applicant, in preparing the response, to consider fully the entire references as well as the context of all references passages as potentially teaching all or part of the claimed inventions.

### ***Status of Claims***

2. Claims 1-12 were canceled per the Amendment received on December 29, 2002.

Claims 13-25 were added as requested in the same Amendment and are now pending.

### ***Priority***

3. In the Office Action dated September 19, 2002, acknowledgment was made of Applicant's claim for foreign priority based on an application filed in Australia on 08/11/1999. It was noted, however, that applicant had not filed a certified copy of the Australian application as required by 35 U.S.C. 119(b). This issue remains outstanding and no certified copy of the referenced foreign application has been received as of the date of this Final Action.

### ***Response to Amendment & Request for Consideration***

4. Applicant's arguments with respect to the original claims 1-12 have been considered but are moot in view of the new ground(s) of rejection as applied to the new claims 13-25.

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***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claims 13, 15, 17, 19, 20-22, 24** are rejected under 35 U.S.C. 102(e) as being anticipated by **David**, US Patent Application Publication No. US 2002/0073046 A1.

As per **claims 13, 17, 22**.

David discloses all the limitations of claim 13, 17, 22:

*In an Internet system having a plurality of computers connected by a network, a [method, system, and computer executable software on storage media] executable at host server having a database to transfer funds (David: Abstract; Summary of the Invention: Page 2, P22) in any currencies (David: P10, P139: "currency") over a network, comprising (David, P7, P85-88; Fig 6-8, associated text):*

*prompting payer to input payer's account identifier and password;  
authenticating the said payer's account identifier and password for validity;  
prompting the payer to input payee's account identifier and fund transfer information;  
receiving said payee's account identifier and fund transfer information;  
upon authenticating the payee's account identifier, crediting the fund to payee's account if the balance in the database associated with the payer account identifier and password is more than the fund for transfer; and debiting the balance associated with the payer's account identifier and password in the database with the said fund transferred to payee's account.*

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As per claims 15, 19, 24.

David discloses all the limitations of claims 15, 19 and 24 (see above citations; Figs 6, 7, 8, associated text):

*In an Internet system having a plurality of computers connected by a network, a [method, system, and computer executable software on storage media] using a convertible prepaid card for payment to a merchant in any currencies over a network comprising:*

*at the merchant server, receiving a request for payment for good or services by purchaser;  
generating a first dynamic transaction code to the host server;  
generating a second dynamic transaction code to the purchaser;  
at the host server having a database, receiving the first transaction code from merchant server;  
requesting purchaser to provide second transaction code and security code from prepaid card;  
receiving the second transaction code and security code as inputted by purchaser;  
authenticating the first transaction code and second transaction code;  
authenticating the said security code for validity;  
upon authentication of the security code, crediting the amount requested for payment o  
merchant's account if the balance in the database associated with the security code is more than the  
requested amount for payment;  
debiting the balance associated with the security code in the database with the said amount paid  
to merchant's account; and  
notifying merchant server and purchaser.*

As per claim 21.

David discloses all the limitations of claim 19.

David also discloses all the limitations of claim 21 (David: P5, P56):

*The system of Claim 19 wherein said transaction codes comprising  
encrypted purchase information, amount, merchant information and a fixed period of expectancy.*

### **Claim Rejections - 35 USC § 103**

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 16, 20, 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over David.

David discloses all the limitations of claims 15, 19, 24, respectively.

David does not specifically disclose a currency conversion step and confirmation that the user approves of a resulting transaction value and stored value. However David did disclose (see USC 35 § 102(e) rejection of claim 13 above) that his invention would accommodate any stored value in any currency. Therefore it would have been obvious to one ordinarily skilled in the art that any transaction system designed to work over global electronic networks such as the Internet would require a currency conversion step and user confirmation/acceptance of the results of such step whenever funds are being debited from or credited to the user's stored value card. Such a system would inherently require this feature to make it attractive and useful to users all over the world, and would therefore comprise the limitations of claims 16, 20, 25:

*... where the said amount payable is in a currency other than the prepaid card's currency further comprising steps at the host server:*

*requesting purchaser to convert the equivalent amount in prepaid card's currency to the requested foreign currency amount if the balance in the database is more than the requested equivalent foreign currency amount for payment;*

*receiving approval by purchaser for converting the said equivalent amount to the requested foreign currency amount for the transaction;*

*crediting the converted amount in foreign currency for payment to merchant's account; and debiting the said credited amount equivalent in prepaid card's currency associated with the purchaser's prepaid card account in the database.*

9. Claims 14, 18, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over David in view of Stimson et al., US Patent No 5,577,109.

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David discloses all the limitations of claims 13,17, 22, respectively.

David does not disclose the activation of a debit card as part of his invention.

Stimson, however, does disclose how a debit card may be activated and discloses the following limitations of claims 14, 18, 23 (Stimson: C2, L1-4; L25-30; L32-36; L38-39; L42-44; C3 L64-67):

*...prompting user to enter security code associated with the prepaid card;  
receiving the security code;  
determining if the security code is valid;  
determining if any identifier account is associated with the security code;  
if there is no account identifier associated with said code then prompt user to enter an unique  
user account identifier, password, ...to be stored;  
receiving the said user account identifier, password, ...as inputted by user;  
determining said user account identifier and password for uniqueness against other stored user  
account identifiers and passwords; ...and  
if said user account identifier, password combination is unique and stored value is acceptable to  
user then add said account identifier and password into database linked with the stored value amount.*

It would have been obvious to one ordinarily skilled in the art at the time the invention was made to have included an activation method as described by Stimson in a system based on David's invention, in order to provide a stronger protection element to the debit/stored value card system: the card user will be assured that only once properly activated by him/herself, will the account associated with the card be accessible for transactions.

Neither David nor Stimson specifically discloses a currency conversion step and confirmation that the user approves of the resulting stored value. However David did disclose (see USC 35 § 102(e) rejection of claim 13 above) that his invention would accommodate any stored value in any currency. Therefore it would have been obvious to one ordinarily skilled in the art that any transaction system designed to work over global electronic networks such as the Internet would require a currency conversion step and user confirmation/acceptance of the result of such step whenever additional funds are being charged to the user's stored value card. Such a system would require this feature to make it attractive and useful to users all over the world, and would therefore comprise the remaining limitations of claims 14, 18, 23:

*...storage period and currency  
...calculating the stored value;  
...output stored value to user;*

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**Conclusion**

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

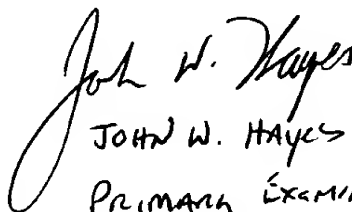
Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Q Le whose telephone number is 703-305-4567. The examiner can normally be reached on 8:30am-5:30pm Mo-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on 703-305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-8494 for regular communications and 703-746-8494 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

DQL

March 10, 2003

  
JOHN W. HAYES  
Primary Examiner